

## REMARKS/ARGUMENTS

### Drawings

The above noted replacement sheets attached hereto reflect drawing changes intended to address all of the objections made by the Examiner.

In particular, with reference paragraph 8 of the Office Action, the figures have been amended to Fig. 3a, Fig. 3b, Fig. 6a and Fig. 6b, so as to address the examiner's objections.

With reference to paragraph 4 of the Office Action, Fig. 2 has been amended to include reference numerals to the objected items. Further, text already existing in the description has been added to:

- i) Paragraph 59 in response to the objection relating to Fig. 4;
- ii) Paragraph 65 in response to the objection relating to Fig. 5, and;
- iii) Paragraph 74 in response to the objection relating to Fig. 6b.

As respects the objections to Fig. 3a and Fig. 6a, applicant notes that the reference numbers used there are correct, and have been described in the specification at paragraphs 54, 55 (Fig. 3a) and 56 (Fig. 6a).

Fig. 8 has been amended to remove the incorrect arrow.

With reference to paragraph 5 of the Office Action, Fig. 1 has been amended to include reference numeral "1". Reference numeral "32" at paragraph 65, is an error, and should actually read "23" which has been consistently applied to "transponder reader/writers" throughout the specification.

With reference to paragraph 6 of the Office Action, reference numeral "9" has been inserted in the description at paragraph 54.

With reference to paragraph 7, the reference numeral "16" has been replaced with "32" at paragraph 61.

Applicant respectfully requests the Examiner's approval of the amended drawings.

### Specification (including Abstract)

The above-noted attached substitute specification is intended to address all of the Examiner's objections.

In particular, with reference to paragraph 13 of the Office Action, suitable sections headings, where applicable, have been added to the specification.

With reference to paragraph 14, the title has been amended in line with the Examiner's suggestion.

With reference to paragraph 15, the errors have generally been amended in line with the Examiner's suggestions. The exceptions are the term "metres" which reflects the correct spelling according to Standard International Units, rather than "meters".

A substitute abstract is also attached, comprising revisions intended to address the Examiner's objections.

The Examiner's approval of the substitute specification is respectfully requested.

### **Claims**

By this amendment, claims 1 – 4, 6, 7, 10 – 32 are in the application. Reconsideration is respectfully requested.

### **Claim Objections**

Applicant has amended the claims to address the objections made in paragraphs 17 – 19 of the Office action.

### **Claim Rejections 35 USC 101 and 35 USC 112, Second Paragraph**

As respects paragraphs 22 – 23 of the Office action, the amendments to claim 23 make it clear that claim 23 is written as a proper system claim that depends from another system claim. Applicant believes that this objection may now be withdrawn.

### **Claim Rejections 35 USC 102**

Claims 1 – 3, 5 – 10, 12, 21, and 24 have been rejected as anticipated by the disclosure of Denne et al, US Patent Number 4,691,202. For the following reasons, applicant believes that this rejection may be withdrawn.

Claim 1 has been amended to include the subject matter of now cancelled claims 5, 8 and 9 and to include the limitation: "*wherein the location of the transponder is determined from the location of the transponder reader.*" Independent claim 24 has also been amended to include this limitation. Support for this further limitation may be found at paragraph 0064 of the specification whereby the physical location of the transponder reader provides a log of the transponder location over a period of time.

In paragraph 35 of the Office action, Denne is said to disclose a security system “*wherein the transponder reader is mounted within the secure area and has a location code which provides information as to the location of the transponder reader. (Col. 1, Lines 26-29)*”

In reply, applicant notes that the disclosure in Denne provides for a transponder reader located at a door. There is no disclosure that the system is made aware of the transponder on interrogation from the transponder reader, but merely provides access through the door for which the transponder reader is located. Thus, there is no ability of the system described in Denne to locate the transponder as a result of an interrogation signal by the transponder reader. Thus, the disclosure in Denne at column 1, lines 26 to 29, merely discloses receivers providing a response to a question of entry. There is no disclosure that one door is different from another so there is no disclosed ability by the system of Denne to locate the transponder or in fact even locate the transponder reader resulting directly from the interrogation signal.

Applicant therefore submits that the ability to locate the transponder has not been disclosed by Denne and therefore, Denne does not anticipate claims 1 and 24 as currently amended. Accordingly, those claims and the claims depending therefrom are believed to be in condition for allowance.

**Claim Rejections 35 USC 103**

Applicant respectfully traverses the claim rejections based on obviousness. In this regard, applicant notes that a proper *prima facie* case of obviousness has not been made.

As an initial matter, the Tuttle reference should not be relied upon in formulating an obviousness rejection because that reference is not analogous art (MPEP 2141.01(a)). In particular, Tuttle refers to anti-theft means, and so is directed solely to the “transponder” rather than the system of claim 1 and its dependent claims. Specifically, Tuttle proposes a transceiver to be mounted to an integrated circuit (IC), to track potential theft. It is not related to maintaining security of a secure area, whereby a user of a transponder may not be entitled to be present. Tuttle, therefore, is not in the field of applicant’s endeavor nor is it reasonably pertinent to the particular problem (maintaining security of an area) with which the claimed invention is concerned. Accordingly, all rejections based on the combination of Dunne and Tuttle should be withdrawn because Tuttle cannot be considered analogous art.

As stated in MPEP sections 2143, to establish a proper *prima facie* case of obviousness, the combined prior art references must teach or suggest all the claim limitations. In the case at

hand, neither Dunne (as discussed above) nor Tuttle provide a means of locating a transponder based on the known location of a transponder reader. As stated at column 9 line 17 - 50 of Tuttle, a reader must either be brought to a location where it is suspected a stolen IC may be (line 19) or put in a fixed position, and IC's brought proximate to the location by conveyor (line 43). This is quite unlike locating a transponder, which may be anywhere in a particular area, through an interrogation received from the reader, and then having the system use the location of that reader to determine the location of the transponder. Since the combined references fail to teach or suggest this claim limitation, a proper *prima facie* case of obviousness has not been made, and the rejection, therefore, should be withdrawn.

Applicant also disagrees with what is set forth in the Office action as a motivation for combining Dunne and Tuttle (paragraph 44 of the Office action). There it is stated that: "*The motivation for combining Dunne et al (202) and Tuttle (174) would be to prevent an unauthorized user from stealing a transponder and using it....*" In reply, applicant notes that a motivation to combine references (which is required to properly establish a *prima facie* case of obviousness; MPEP 2143(01)) is not found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill. In this regard, "*The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.*" *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed Cir. 2000, emphasis added).

Applicant submits that anyone stealing the IC of Tuttle would wish to disable the transponder, not use it. Therefore, Tuttle is not directed to the same problem solved by the present invention and is does not provide any motivation for combining Dune and Tuttle. Thus, for this reason (in addition to those set forth above) the obviousness rejection based on the combination of Dunne and Tuttle should be reversed.

With reference to the obviousness rejections based on the proposed combinations that employ Miller, Bowers, Ogasawara and Nerlikar, applicant notes that whilst these systems suggest the use of RFID, none use this technology for the location of a transponder, based on the location of a reader having sent an interrogation signal. Accordingly, none of the cited prior art discloses or suggests the invention as now claimed, either separately or in combination.

**Conclusion**

In view of the foregoing, applicant believes that all of the currently pending claims are in condition for allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions, he is invited to contact applicant's attorney at the below-listed telephone number.

Respectfully submitted,  
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